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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,237	04/15/2004	Carolyn W. Hall	HALL-101C	7769
7590 08/20/2004 Robert K. Tendler 65 Atlantic Avenue Boston, MA 02110			EXAMINER CHRISTMAN, KATHLEEN M	
			ART UNIT 3713	PAPER NUMBER
DATE MAILED: 08/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,237

Applicant(s)

HALL ET AL.

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION***Priority***

Applicant is requested to update the continuing information in the first line of the specification to include the current status of the parent application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. **Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-17 of U.S. Patent No. 6,767,211 B2.** Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The claims of the patent include the additional limitation of a "series of non-knowledge based guided practice activities" and "transmitting the series of guided practice activities to the individual". The difference in the claims merely being the number of guided practice activities sent to the user. As the number of exercises sent to the user is merely a subjective part of the educational process, the modification of either a series of guided practice activities or a single guided practice activity is an obvious matter of design choice.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 2, 5-7, and 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Claims 2, 6-7 and 9-17 each refers to “the guided practice activity”. However, claim 1, from which the claims depended either directly or indirectly, recites a non-knowledge based guided practice activity and a remediative guided practice activity. It is unclear which of the guided practices the applicant intends to refer back to. For purposes of examination the examiner has interpreted these limitations to refer to the first non-knowledge based guided practice. Claim 5 recites “the individual guided practice activities”, this phrase lacks antecedent basis. It is unclear as to which guided practice activity the applicant is intending to refer. For purposes of examination the examiner has interpreted the limitation as referring to the first non-knowledge based guided practice.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 2, and 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman et al (US 631462).** Freeman et al teaches an adaptive method for teaching including the steps of: providing

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at an Internet site (web based program, col. 1: 60 and col. 8:51-67); a course of scenario based instruction having a mini-content object (motivational content, col. 5: 66 - col. 6: 3) and a non-knowledge based guided practice activity to be performed by an individual, the guided practice activity involving no right or wrong answer but rather behavioral tasks to be performed, the guided practice activity including information on how to modify performance (the learn by doing modules, col. 6: 25-34); automatically transmitting the mini-content object to the individual; automatically transmitting , after the mini-content object, the guided practice activity to the individual at a known time (the student has logged into the system, they therefor are aware they will be receiving the content), thus to provide the individual with an active learning experience through the guided practice activity (see Figure 3); assessing the individual's behavioral performance by pushing content to the individual to evaluate the individual's reaction to the content, thus to permit providing updated guided practice activities; transmitting back to the Internet site the individual's reaction to the content (the assessment, col. 6:66 – col. 7: 3); and adaptively providing a remediative guided practice activity back to the individual, the adaptation based on the individual's reaction to the pushed content (Figure 5, and col. 7: 40-60), as in **claim 1**. Regarding **claims 2 and 8**, the user of the Freeman et al system is selecting the times at which they wish to take the courses, as such the times must be those which do not interfere with their normal schedules/task, see col. 1: 41-50 and col. 7: 65 – col. 8:3. Similarly **claim 5** recites that the guided practices are “time limited” so as not to interfere with the normal tasks of the individual. The recitation “so as not to interfere with the normal tasks of the individual” recites the applicant's intended purpose of time limiting the activities and is not limiting to the claim. The tasks of the Freeman et al method are “time limited” in that the system monitors the amount of time spent on the exercise and offers a new exercise if a time limit is exceeded, see Figure 5, 511. Regarding **claim 3**, Freeman et al teaches using the TCP/IP transport protocol to send information to the user. This protocol inherently includes a receipt confirmation of all data sent. As the applicant has not specifically recited who acknowledges receipt of the guided practice, this inherent feature of the protocol meets the requirements of the claim. Regarding **claim 4**, providing additional guided practices from the Internet Site is taught in the additional modules; see Figure 4, 414 and Figure 5, 512. Regarding **claims 6 and 7**, the user is provided with a device with which the guided practice

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activities are transmitted, specifically the device is a computer, see col. 5: 51-56. The guided practice activity including experiential learning in which the individual is prompted to respond with some action, as in **claim 9**, is taught in at least col. 6: 35-37.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al (US 6301462 B1) in view of Casey-Cholakakis et al (US 6438353 B1).** Freeman et al teaches all aspects of the claim as shown above but fails to specifically teach that the guided practice is designed to improve competency in the workplace (**claim 10**) or designed to empower women to react to specific workplace encounters with positive results (**claim 13**). Casey-Cholakakis et al teaches using an educational system to educate a student on office policies and thereby improve competency, the policies including sexual harassment and proper responses to such. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the educational content of the Casey-

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Cholakis et al reference within the Freeman et al system so as to provide educational material on various workplace issues.

5. **Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al (US 6301462 B1) in view of Tsumori et al (US 6435880 B1).** Freeman et al teaches all aspects of the claim as shown above but fails to particularly teach that the guided practice activity, an athletic activity (**claim 11**), where the athletic activity is golf (**claim 12**), Each of the limitations is a variation of the subject matter presented to the user upon receipt of the guided practice. Tsumori et al teaches using an educational system for modifying behavior and teaching a user various athletic activities, including golf. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the educational content of the Tsumori et al reference within the Freeman et al system so as to provide educational material on a plurality of sports topics.

6. **Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al (US 6301462 B1) in view of Brown et al (US 5879163).** Freeman et al teaches all aspects of the claim as shown above but fails to specifically teach that the guided practice is designed to improve the response of the individual to health related issues (**claim 14**) wherein the health related issues in controlling the weight of the individual (**claim 15**), addiction (**claim 16**) or the taking of medication (**claim 17**). Each of the limitations is a variation of the subject matter presented to the user upon receipt of the guided practice. Brown et al teaches using an education system to modify behavior for various medical conditions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the educational content of the Brown et al reference within the Freeman et al system so as to provide educational material on various medical topics.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- a. Bro (US 5722418) teaches a system for monitoring a patient's health. Includes adaptive suggestions for behavior modification
- b. Smith (US 6338628) teaches a behavior modification system in which a personality profile is used to determine appropriate treatment

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen M Christman
Examiner
Art Unit 3713

August 19, 2004